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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,922

Applicant(s)

MACALUSO, ANTHONY G.

Examiner

MATTHEW C. SAMS

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on 9/21/2007.
2. Although the applicant's remarks state claims 1, 17, 26-28 & 34 have been amended, no amendments were received and this statement was confirmed by a telephone call to Hwa C. Lee.

Information Disclosure Statement

3. The information disclosure statement filed on 10/8/2007 has been considered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6, 7, 17, 21 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda (US-6,665,533) in view of Van Erlach et al. (US 2003/0179229 hereinafter, Van Erlach).

Regarding claim 1, Sakoda teaches a method for advertising (Abstract, Col. 2 lines 20-23 and Col. 9 line 59 through Col. 10 line 4) on a mobile device (Col. 4 lines 48-52), the method comprising:

storing a plurality of advertisements on a mobile device; (Col. 10 lines 22-27 and Col. 11 lines 13-16)

initiating a wireless communication involving the mobile device; (Fig. 1, Fig. 7 [Activate Command], Col. 9 line 65 through Col. 10 line 4 and Col. 10 lines 10-16)

determining a time required to complete the wireless communication. (Col. 8 lines 55-61)

Sakoda teaches displaying to the user the time remaining (*i.e.* waiting time) until a requested wireless communication is completed (Col. 8 lines 55-58), displaying advertisements during the waiting time (Col. 8 lines 59-61), the display of an advertisement ends as soon as the requested wireless communication has been received (Col. 8 lines 62-67) and includes that a "variety of methods can be considered for selecting an advertisement to be displayed from such a plurality of advertisements" (Col. 10 lines 55-57), but differs from the claimed invention by not explicitly reciting selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.

In an analogous art, Van Erlach teaches a method and system for selecting content or advertisements (Page 1 [0009]) to provide to a user interface of a mobile device (Page 1 [0007]) that includes selecting an advertisement based on the time available for an advertisement. (Page 2 [0011]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method displaying advertisements of Sakoda after modifying it to incorporate the

selecting of advertisements due to time constraints of Van Erlach since Sakoda is open to a variety of display priorities and it is common sense that if only part of an advertisement is seen because there is not enough time to view it in the entirety, the advertisement might not be effective.

Regarding claim 2, Sakoda in view of Van Erlach teaches downloading the advertisement to the mobile device over a wireless interface. (Sakoda Col. 3 lines 11-23 & Col. 5 lines 28-33)

Regarding claim 3, Sakoda in view of Van Erlach teaches the wireless communication comprises download of data to the mobile device. (Sakoda Col. 5 lines 28-33 and Col. 8 lines 51-61)

Regarding claim 4, Sakoda in view of Van Erlach teaches the download of data comprises data used by an application running on the mobile device. (Sakoda Col. 3 lines 11-23 "control means")

Regarding claim 6, Sakoda in view of Van Erlach teaches the download of data content (Sakoda Col. 7 lines 9-13) and it is obvious and well known to one of ordinary skill in the art that a download of data/information can comprise an application file, an HTML web page, a text document, an executable file or any other type of content. (Sakoda Col. 7 lines 9-13)

Regarding claim 7, Sakoda in view of Van Erlach teaches presenting the advertisement on the mobile device comprises presenting the advertisement during a delay period, with the delay period representing a time during which the download of data occurs. (Col. 8 lines 51-61)

Regarding claim 17, the limitations of claim 17 are rejected as being the same reason set forth above in claim 1.

Regarding claim 21, the limitations of claim 21 are rejected as being the same reason set forth above in claim 4.

Regarding claim 34, Sakoda teaches a method of advertising on a mobile device, the method comprising:

storing a plurality of advertisements on a mobile device; (Sakoda Col. 10 lines 22-27 and Col. 11 lines 13-16)

initiating a wireless communication session involving the mobile device; (Sakoda Fig. 1, Fig. 7 [Activate Command], Col. 9 line 65 through Col. 10 line 4 and Col. 10 lines 10-16)

determining a time required to complete the wireless communication, the time representing a period of delay in the wireless communication session. (Sakoda Col. 8 lines 55-61)

Sakoda teaches displaying to the user the time remaining (*i.e.* waiting time) until a requested wireless communication is completed (Col. 8 lines 55-58), displaying advertisements during the waiting time (Col. 8 lines 59-61), the display of an advertisement ends as soon as the requested wireless communication has been received (Col. 8 lines 62-67), including a "variety of methods can be considered for selecting an advertisement to be displayed from such a plurality of advertisements" (Col. 10 lines 55-57) and differing "successively viewed advertisements" (Col. 9 lines 9-13), but differs from the claimed invention by not explicitly reciting presenting a rotation

of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time.

In an analogous art, Van Erlach teaches a method and system for selecting content or advertisements (Page 1 [0009]) to provide to a user interface of a mobile device (Page 1 [0007]) that includes selecting an advertisement based on the time available for an advertisement. (Page 2 [0011]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method displaying advertisements of Sakoda after modifying it to incorporate the selecting of advertisements due to time constraints of Van Erlach since Sakoda welcomes the idea of implementing a variety of methods for selecting advertisement display priorities (Sakoda Col. 11 lines 9-16) and explicitly teaches differing successively viewed advertisements (Sakoda Col. 9 lines 9-13), it is well within the scope of one of ordinary skill to realize that if the waiting time is much longer than any one stored advertisement, in order to keep the user entertained for the waiting time, to continue to show different advertisements, as suggested by Sakoda. (Col. 9 lines 9-13)

Regarding claim 35, the limitations of claim 35 are rejected as being the same reason set forth above in claim 2.

Regarding claim 36, the limitations of claim 36 are rejected as being the same reason set forth above in claim 7.

6. Claims 8-13, 16, 18-20, 26-33 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 1 above, and further in view of Hamano et al. (US 2002/0166127 hereafter, Hamano).

Regarding claim 8, Sakoda in view of Van Erlach teaches the limitations of claim 1 above including keeping track of the date an advertisement was received (Col. 7 lines 46-51), but differs from the claimed invention by not explicitly reciting the determining that the stored advertisement has expired and sending a notification of the expiration in response to the expiration determination.

In an analogous art, Hamano teaches a system and method for providing advertisements to a wireless terminal that includes determining if the advertisement has expired and updating the advertisement if required. (Fig. 2, Page 2 [0028] and Page 3 [0033]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the method of advertising of Sakoda in view of Van Erlach after modifying it to incorporate the checking for advertisement expiration dates and updating the advertisements if required of Hamano. One of ordinary skill in the art would have been motivated to do this since it allows the viewer to see the most current and accurate advertisement available and eliminates false hopes that can occur if an expired ad is viewed. (Hamano Page 3 [0033])

Regarding claim 9, Sakoda in view of Van Erlach and Hamano teaches the notification comprises a request for a new advertisement. (Hamano Page 2 [0028] and Fig. 2)

Regarding claim 10, Sakoda in view of Van Erlach and Hamano teaches the stored advertisement has expired based on at least one of an expiration time and a number of times the advertisement is presented. (Hamano Page 2 [0028] and Page 3 [0033])

Regarding claim 11, Sakoda in view of Van Erlach and Hamano teaches the notification comprises a request for a new expiration time. (Hamano Page 3 [0032-0033])

Regarding claim 12, Sakoda in view of Van Erlach and Hamano teaches receiving a new advertisement in response to the notification. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 13, Sakoda in view of Van Erlach and Hamano teaches receiving at least one of an expiration time for the new advertisement and an assigned number of times to present the new advertisement. (Hamano Fig. 2, Page 2 [0028], Page 3 [0032-0033] and Page 6 [Claim 12])

Regarding claim 16, Sakoda in view of Van Erlach and Hamano teaches monitoring at least one of a number of times the stored advertisement is presented and a frequency that the stored advertisement is presented. (Sakoda Col. 7 lines 46-51 & Hamano Page 6 [Claim 12])

Regarding claim 18, the limitations of claim 18 are rejected as being the same reason set forth above in claim 8.

Regarding claim 19, the limitations of claim 19 are rejected as being the same reason set forth above in claim 10.

Regarding claim 20, the limitations of claim 20 are rejected as being the same reason set forth above in claims 9 and 11.

Regarding claim 26, Sakoda in view of Van Erlach and Hamano teaches a communications system (Sakoda Fig. 1, Van Erlach Fig. 1, and Hamano Fig. 1), comprising:

a wireless telecommunications network operable to support communications with mobile devices; (Sakoda Fig. 1 [20])

a central advertising server (Sakoda Fig. 1 [10] and Col. 5 lines 28-33) in communication with the wireless telecommunication network (Sakoda Fig. 1 communication lines between 10 & 20)) and adapted to store advertisements for presentation on mobile devices during wireless data communications that cause a delay on the mobile devices (Sakoda Col. 8 lines 51-61), wherein the central advertising server is further adapted to:

receive a request for a new advertisement from an advertising application on a mobile device storing one or more advertisements; (Hamano Page 2 [0028] and Fig. 2)

receive information related to one of the stored advertisements from the advertising application on the mobile device; (Sakoda Col. 7 lines 46-51 and 65-67)

update a database record associated with the one of the stored advertisements based on the received information; (Sakoda Col. 7 lines 46-51 and 65-67)

determine whether at least one new advertisement is available; (Hamano Page 2 [0028] and Page 3 [0033]) and

transmit a selected new advertisement to the mobile device if at least one new advertisement is available (Hamano Page 3 [0032-0033]), wherein the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time. (Van Erlach Page 2 [0011])

Regarding claim 27, Sakoda in view of Van Erlach and Hamano teaches receiving responses from the mobile terminals regarding feedback information about how many times advertisements were displayed (Sakoda Col. 7 lines 46-51 & 65-67), which obviously motivates the service provider to create, maintain and analyze statistical information regarding expected fees and advertisement views/success rates of advertisements because an advertiser's views/success rate would be the best selling point for getting new advertisers. (Sakoda Col. 7 lines 65-67)

Regarding claim 28, Sakoda in view of Van Erlach and Hamano teaches the statistics relating to the one of the stored advertisements include at least one of a number of times the one of the stored advertisements has been presented on the mobile device (Sakoda Col. 7 lines 46-51 & 65-67), a number of presentations that have been assigned to the mobile device, a number of requested presentations for the one of the stored advertisements and an expiration time for the one of the stored advertisement. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 29, the limitations of claim 29 are rejected as being the same reason set forth above in claim 13.

Regarding claim 30, Sakoda in view of Van Erlach and Hamano teaches the central advertising server (Sakoda Fig. 1 [10]) assigns an expiration time for the

selected new advertisement and transmits the assigned expiration time to the mobile device. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 31, Sakoda in view of Van Erlach and Hamano teaches the central advertising server is adapted to select the new advertisement according to a priority weighting procedure. (Hamano Page 4 [0042] & Page 6 [Claim 12])

Regarding claim 32, Sakoda in view of Van Erlach and Hamano teaches the priority weighting procedure relates to at least one of a remaining number of requested presentations for each advertisement and a time remaining until an expiration time for each advertisement. (Hamano Page 3 [0032-0033], Page 4 [0042] & Page 6 [Claim 12])

Regarding claim 33, Sakoda in view of Van Erlach and Hamano teaches the central advertising server (Sakoda Fig. 1 [10]) can determine if a new expiration time for a current advertisement is available if at least one new advertisement is not available and transmit a new expiration time for the current advertisement if a new expiration time for the current advertisement is available. (Hamano Page 2 [0028], Page 3 [0032-0033], page 4 [0042] & Page 6 [Claim 12])

Regarding claims 37-39, the limitations of claims 37-39 are rejected as being the same reason set forth above in claim 8-10.

7. Claims 5 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claims 4 and 21 above, and further in view of Sanctis et al. (US-2005/0131837 hereinafter, Sanctis).

Regarding claim 5, Sakoda in view of Van Erlach teaches the limitations of claim 4 above, but differs from the claimed invention by not explicitly reciting the application comprises a Binary Runtime Environment for Wireless application.

In an analogous art, Sanctis teaches a method of advertising product information to a mobile device (Abstract) that includes data that is downloaded of data by an application running on the mobile device (Sanctis Page 6 [0051]), wherein the application comprises a Binary Runtime Environment for Wireless application. (Sanctis Page 5 [0040]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method of advertising on a mobile device of Sakoda in view of Van Erlach after modifying it to incorporate the BREW application of Sanctis since mobile devices obviously require an operating system and BREW can be considered one option available as an operating system for third generation cellular.

Regarding claim 22, Sakoda in view of Van Erlach and Sanctis teaches the application initiates the wireless data communication. (Sanctis Page 5 [0037-0038])

Regarding claim 23, Sakoda in view of Van Erlach and Sanctis teaches the wireless data communication involves data needed by the application to perform an operation requested by a user of the mobile device. (Sanctis Page 4 [0033-0035])

Regarding claim 24, Sakoda in view of Van Erlach and Sanctis teaches the application runs on a Binary Runtime Environment for Wireless platform. (Sanctis Page 5 [0040])

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 1 above, and further in view of Rakavy et al. (US-5,913,040 hereinafter, Rakavy).

Regarding claims 14 and 15, Sakoda in view of Van Erlach teaches the limitations of claim 1 above, but differs from the claimed invention by not explicitly reciting the stored advertisement comprises a bitmap.

In an analogous art, Rakavy teaches a method and system for providing advertisements to a user's computer by transmitting information in the background (*i.e.* prior to being needed and without disturbing the user [Abstract]) that includes storing advertisements as bitmaps or animations (Col. 7 lines 13-29), wherein it is obvious to one of ordinary skill in the art that if a bitmap has multiple frames and they are shown sequentially, the user is viewing an animation. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method of advertising of Sakoda in view of Van Erlach after modifying it to incorporate the use of bitmaps and animations for advertisements of Rakavy since bitmaps can be highly compressed (which is important because memory will be limited on a mobile device) and bitmaps can easily be linked together to provide a simple animation.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 17 above, and further in view of Levin et al. (US-2002/0128908 hereinafter, Levin).

Regarding claim 25, Sakoda in view of Van Erlach teaches receiving responses from the mobile terminals regarding feedback information about how many times advertisements were displayed (Sakoda Col. 7 lines 46-51 & 65-67), which obviously motivates the service provider to create, maintain and analyze statistical information regarding expected fees and advertisement views/success rates of advertisements because an advertiser's views/success rate would be the best selling point for getting new customers. An example of such a well known method for data reporting can be seen in Levin Fig. 5.

Response to Arguments

10. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW C. SAMS whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571)272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS
3/13/2008

/George Eng/
Supervisory Patent Examiner, Art Unit 2617